

REMARKS

The Examiner objected to claims 4-6 and 12-14 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The Examiner rejected claims 1-3, 7-11 and 15-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gauthier et al. (USP 6,781,355) in view of Cooper et al. (USP 5,049,841).

The Examiner rejected claims 1-3, 7-11 and 15-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gauthier et al. (USP 6,781,355) in view of Iwamura et al. (USP 4,860,148).

Applicants respectfully traverse the §103 rejections with the following arguments.

35 U.S.C. §103

The Examiner rejected claims 1-3, 7-11 and 15-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gauthier et al. (USP 6,781,355) in view of Cooper et al. (USP 5,049,841).

Applicants respectfully contend that claim 1 is not unpatentable over Gauthier in view of Cooper, because Gauthier in view of Cooper does not teach or suggest each and every feature of claim 1. For example, Gauthier in view of Cooper does not teach or suggest "a controller being electrically connected to the electrical switch and being configured to *open* the electrical switch to reduce the transient voltage variation across the circuit" of claim 1 (*italic emphasis added*).

The Examiner argues that the resonance detector 512 in Fig. 5 of Gauthier represents the controller of claim 1. In response, Applicants note that Gauthier in column 4, lines 25-35 states that "Under non-resonant conditions, the damping element (514) should approximate an open circuit, thereby dissipating no power when it is not needed. The resonance detector (512) monitors transmissions between the integrated circuits (510, 516) on line (518) and determines whether a transmission will cause a power supply resonance condition. If a transmission is determined to cause a power supply resonance condition, the resonance detector (512) will activate the damping element (514) so that the damping element (514) may damp the power supply resonance." In other words, the resonance detector (512) of Gauthier is configured to *close* the damping element (514) so as to reduce (i.e, damp) a power supply resonance condition (*italic emphasis added*). In contrast, the controller of claim 1 is configured to *open* the electrical switch to reduce the transient voltage variation across the circuit (*italic emphasis added*).

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not

unpatentable over Gauthier in view of Cooper, and that claim 1 is in condition for allowance. Since claims 2-3 and 7-8 depend from claim 1, Applicants contend that claims 2-3 and 7-8 are likewise in condition for allowance.

Applicants respectfully contend that claim 9 is not unpatentable over Gauthier in view of Cooper, because Gauthier in view of Cooper does not teach or suggest each and every feature of claim 9. For example, Gauthier in view of Cooper does not teach or suggest "causing the controller to *open* the electrical switch to reduce the transient voltage variation across the circuit" of claim 9 (*italic emphasis added*).

The Examiner argues that the resonance detector 512 in Fig. 5 of Gauthier represents the controller of claim 1. In response, Applicants note that Gauthier in column 4, lines 25-35 states that "Under non-resonant conditions, the damping element (514) should approximate an open circuit, thereby dissipating no power when it is not needed. The resonance detector (512) monitors transmissions between the integrated circuits (510, 516) on line (518) and determines whether a transmission will cause a power supply resonance condition. If a transmission is determined to cause a power supply resonance condition, the resonance detector (512) will activate the damping element (514) so that the damping element (514) may damp the power supply resonance." In other words, Gauthier teaches causing the resonance detector (512) to *close* the damping element (514) so as to reduce (i.e., damp) a power supply resonance condition (*italic emphasis added*). In contrast, the method of claim 9 comprises causing the controller to *open* the electrical switch to reduce the transient voltage variation across the circuit (*italic emphasis added*).

Based on the preceding arguments, Applicants respectfully maintain that claim 9 is not unpatentable over Gauthier in view of Cooper, and that claim 9 is in condition for allowance.

Since claims 10-11 and 15-16 depend from claim 9, Applicants contend that claims 10-11 and 15-16 are likewise in condition for allowance.

Applicants respectfully contend that claim 17 is not unpatentable over Gauthier in view of Cooper, because Gauthier in view of Cooper does not teach or suggest each and every feature of claim 17. For example, Gauthier in view of Cooper does not teach or suggest "opening the first electrical switch in response to a transient voltage variation across the circuit" of claim 17.

More specifically, Gauthier in column 4, lines 25-35 states that "Under non-resonant conditions, the damping element (514) should approximate an open circuit, thereby dissipating no power when it is not needed. The resonance detector (512) monitors transmissions between the integrated circuits (510, 516) on line (518) and determines whether a transmission will cause a power supply resonance condition. If a transmission is determined to cause a power supply resonance condition, the resonance detector (512) will activate the damping element (514) so that the damping element (514) may damp the power supply resonance." In other words, Gauthier teaches *closing* the damping element (514) so as to reduce (i.e, damp) a power supply resonance condition (*italic emphasis added*). In contrast, the method of claim 17 comprises *opening* the electrical switch in response to a transient voltage variation across the circuit (*italic emphasis added*).

Based on the preceding arguments, Applicants respectfully maintain that claim 17 is not unpatentable over Gauthier in view of Cooper, and that claim 17 is in condition for allowance. Since claims 18-20 depend from claim 17, Applicants contend that claims 18-20 are likewise in condition for allowance.

The Examiner rejected claims 1-3, 7-11 and 15-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gauthier et al. (USP 6,781,355) in view of Iwamura et al. (USP

4,860,148).

Applicants respectfully contend that claim 1 is not unpatentable over Gauthier in view of Iwamura, because Gauthier in view of Iwamura does not teach or suggest each and every feature of claim 1. For example, Gauthier in view of Iwamura does not teach or suggest "a controller being electrically connected to the electrical switch and being configured to *open* the electrical switch to reduce the transient voltage variation across the circuit" of claim 1 (*italic emphasis added*).

The Examiner argues that the resonance detector 512 in Fig. 5 of Gauthier represents the controller of claim 1. In response, Applicants note, as mentioned above, that the resonance detector (512) of Gauthier is configured to *close* the damping element (514) so as to reduce (i.e., damp) a power supply resonance condition (*italic emphasis added*). In contrast, the controller of claim 1 is configured to *open* the electrical switch to reduce the transient voltage variation across the circuit (*italic emphasis added*).

Moreover, the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Gauthier by the alleged teaching of Iwamura in relation to claim 1. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. v. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention") (*emphasis added*). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that

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the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**") (emphasis added). The Examiner has not made any showing of such required suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention as claimed in claim 1. More specifically, the Examiner argues in bullet #3 of the Office Action that "Figure 2 and 3a-3c of Iwamura et al. shows a variable resistor circuit (R28, T7) having low power consumption" and that "it would have been obvious to a person skilled in the art at the time the invention was made to use Iwamura et al's variable resistor circuit in place Gauthier et al's damping circuit *for the purpose of reducing power consumption.*" (italic emphasis added). In response, Applicants note that the switches in FIGs. 2 and 3a-3c of Iwamura are opened when the system is not in operation and are closed during the operation of the system. Such operation of the switches is to (a) provide a protection against surge voltages due to electrostatic charge when the system is not in operation and (b) minimize the delay of signals due to the protective resistance and the parasitic capacitance when the system is in operation (Iwamura, column 3, lines 34-44). As a result, the Examiner has not established suggestion, motivation, or teaching in Iwamura (or elsewhere in the prior art) in regard to the purpose of reducing power consumption that would have led a person of ordinary skill in the art to combine Iwamura with Cooper in a way that would produce the claimed invention as claimed in claim 1. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 1.

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Gauthier in view of Iwamura, and that claim 1 is in condition for allowance. Since claims 2-3 and 7-8 depend from claim 1, Applicants contend that claims 2-3 and 7-8 are

likewise in condition for allowance.

Applicants respectfully contend that claim 9 is not unpatentable over Gauthier in view of Iwamura, because Gauthier in view of Iwamura does not teach or suggest each and every feature of claim 9. For example, Gauthier in view of Iwamura does not teach or suggest "causing the controller to *open* the electrical switch to reduce the transient voltage variation across the circuit" of claim 9 (*italic emphasis added*).

The Examiner argues that the resonance detector 512 in Fig. 5 of Gauthier represents the controller of claim 1. In response, Applicants note, as mentioned above, that Gauthier teaches causing the resonance detector (512) to *close* the damping element (514) so as to reduce (i.e., damp) a power supply resonance condition (*italic emphasis added*). In contrast, the method of claim 9 comprises causing the controller to *open* the electrical switch to reduce the transient voltage variation across the circuit (*italic emphasis added*).

Moreover, as mentioned above, the Examiner has not established suggestion, motivation, or teaching in Iwamura (or elsewhere in the prior art) in regard to the purpose of reducing power consumption that would have led a person of ordinary skill in the art to combine Iwamura with Cooper in a way that would produce the claimed invention as claimed in claim 9. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 9.

Based on the preceding arguments, Applicants respectfully maintain that claim 9 is not unpatentable over Gauthier in view of Iwamura, and that claim 9 is in condition for allowance. Since claims 10-11 and 15-16 depend from claim 9, Applicants contend that claims 10-11 and 15-16 are likewise in condition for allowance.

Applicants respectfully contend that claim 17 is not unpatentable over Gauthier in view of Iwamura, because Gauthier in view of Iwamura does not teach or suggest each and every

feature of claim 17. For example, Gauthier in view of Iwamura does not teach or suggest "opening the first electrical switch in response to a transient voltage variation across the circuit" of claim 17 (*italic emphasis added*).

More specifically, as mentioned above, Gauthier teaches *closing* the damping element (514) so as to reduce (i.e., damp) a power supply resonance condition (*italic emphasis added*). In contrast, the method of claim 17 comprises *opening* the electrical switch in response to a transient voltage variation across the circuit (*italic emphasis added*).

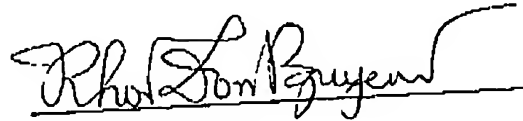
Moreover, as mentioned above, the Examiner has not established suggestion, motivation, or teaching in Iwamura (or elsewhere in the prior art) in regard to the purpose of reducing power consumption that would have led a person of ordinary skill in the art to combine Iwamura with Cooper in a way that would produce the claimed invention as claimed in claim 17. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 17.

Based on the preceding arguments, Applicants respectfully maintain that claim 17 is not unpatentable over Gauthier in view of Iwamura, and that claim 17 is in condition for allowance. Since claims 18-20 depend from claim 17, Applicants contend that claims 18-20 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0456.

Date: March 07, 2005



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